

REMARKS

I. CLAIM STATUS

Claims 1-26 are pending. No claims are amended herein.

Applicants respectfully acknowledge the Examiner's withdrawal of the rejection under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,577,796 and WO 00/21098 (collectively, "Anelli") in view of U.S. Patent No. 5,134,036 to Uemura et al. ("Uemura") and U.S. Patent No. 5,187,226 to Kamachi et al. ("Kamachi"). See July 25, 2008, Office Action at 4.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejects claims 1-26 under 35 U.S.C. § 103 as unpatentable over Anelli¹ in view of Uemura and Kamachi, further in view of U.S. Patent No. 6,350,431 to Snow et al. ("Snow"). See July 25, 2008, Office Action at 2-4. The Examiner reiterates the same rationale for relying upon Anelli, Uemura, and Kamachi as stated in the previous office action, but now also relies upon Snow. In particular, the Examiner asserts that "Snow teaches compounds comprising backbone structures that are substantially similar to that of formula 1 The compounds can be attached to surfactant molecules by means of linking groups and the surfactant molecules have many utilities such as stabilizers. . . . As to the distance between the two hydrogen atoms, Snow teaches that it is the examiner's position that the teachings at column 43, line 27 through column 44 and line 50, would render obvious compounds having the

¹ The Examiner has again improperly relied upon U.S. Patent No. 6,577,796 ("the '796 patent") as prior art. For the reasons set forth in Applicants' prior responses dated April 24, 2008, and November 8, 2008, the '796 patent is not available as prior art under 35 U.S.C. § 103(c).

requisite spacing, in the absence of factual evidence to the contrary." *Id.* at 3-4. The Examiner concludes that it would have been obvious "to modify the teachings of Anelli by using as the stabilizer, the surfactant molecule taught by Snow with the reasonable expectation of obtaining the efficacious properties associated therewith." *Id.* at 4.

Applicants respectfully disagree and traverse this rejection for the reasons of record and for at least the following reasons.

To begin with, Snow is directed to compounds designed and intended for completely different purposes than the hydrolysis stabilizer compound used in Anelli or the claimed invention, and, therefore, one of skill in the art would never have considered the reference let alone thought to combine it with the other prior art references. The M.P.E.P. instructs as follows:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.

M.P.E.P. § 2141.01(a)(I).

Here, Snow is in a field of endeavor that is significantly different and wholly unrelated to the fields of endeavor of the other prior art and of Applicants' claimed invention, and, therefore, it would not "have commended itself to an inventor's attention in considering his or her invention as a whole." For example, Snow expressly explains

to skilled artisans that its disclosure is directed to physiologically tolerable light imaging contrast agent compounds useful in light imaging procedures. See, e.g., Snow at col. 1, lines 10-13; see also *id.* at col. 1, lines 63-67 (object of Snow “to provide light imaging contrast agents . . . suitable for example for studies of blood flow, of perfusion of effusion, and of the vascularization of sites of interest”). Further aspects of Snow disclose methods of treatment of the human or animal body to remove tumorous tissues therefrom consisting of administration of a light-imaging contrast agent compound. See *id.* at col. 7, line 59 – col. 8, line 7; see also *id.* at col. 8, lines 20-53. In stark contrast, the claimed invention is directed to a telecommunication cable comprising, among other things, an elongated element comprising a water-soluble polymeric composition which comprises, among other things, a hydrolysis stabilizer compound. Similarly, Anelli, which the Examiner relies upon to reject the claimed invention, is directed to an optical fiber cable. See Anelli, Abstract.

The Examiner has no basis to suggest that one skilled in the art would consider combining the light imaging contrast agents of Snow with the optical fiber cable of Anelli to arrive at Applicants' claimed invention. First, the Examiner has cited no evidence that one skilled in the art would ever have thought a light imaging contrasting agent suitable for identifying tumors in the body has any relevance whatsoever to an optical fiber cable. In fact, neither the claims nor Anelli bear any relationship, no matter how remote, with light imaging contrast agents, such as those of Snow. Second, the Examiner has cited no evidence that one skilled in the art would appreciate that the light imaging contrasting agent could serve as a hydrolysis stabilizer compound. The Examiner has cited nothing in Snow, Anelli, or any other available reference as suggesting this. The

only thing the Examiner has done is reference Figure 1 of Applicants' specification (July 25, 2008, Office Action at 3), which **does not** suggest that prior to Applicants' filing date a person of ordinary skill in the art could reach that conclusion. Third, in view of the significant difference between the fields of endeavor of Snow and Anelli, there is no reasonable expectation of success from the Examiner's proposed combination.

For at least this reason, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

Moreover, even assuming for the sake of argument that one of skill in the art would have been motivated to combine Snow with Anelli, the Examiner has provided no evidence whatsoever that the compounds disclosed in Snow comprise "a chelant group **comprising two hydrogen atoms bonded to two respective heteroatoms** selected from nitrogen, oxygen and sulphur, **said two hydrogen atoms having a distance between each other of from 4.2×10^{-10} m to 5.8×10^{-10} m**," as presently claimed.

Claim 1 (emphasis added). The Examiner merely provides the unsubstantiated statement that "[a]s to the distance between the two hydrogen atoms, Snow teaches that it is the examiner's position that the teachings at column 43, line 27 through column 44 and line 50, would render obvious compounds having the requisite spacing, in the absence of factual evidence to the contrary." July 25, 2008, Office Action at 3-4. Snow, however, does not support the position of the Examiner. Indeed, Snow says nothing about the distance between the two hydrogen atoms. For at least this additional reason, Applicants respectfully submit that the rejection is in error and should be withdrawn. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead,

there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (cited with approval by *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (2007)).

Finally, even assuming for the sake of argument that one skilled in the art would have been motivated to combine Snow with Anelli, and further assuming for the sake of argument that Snow discloses compounds having hydrogen atoms distanced from each other as claimed, Snow fails to cure all of the deficiencies of the rejection predicated on the combination of Anelli, Uemura, and Kamachi for the same reasons set forth in Applicants’ prior response. Moreover, Applicants’ instant specification discloses unexpected results achieved by addition of a suitable amount of hydrolysis stabilizer having the claimed molecular characteristics. Applicants note, however, that the Examiner in issuing a new rejection never addressed any of the arguments made by Applicants in their prior response. For the sake of brevity, Applicants do not repeat those arguments, but incorporate them by reference. For those additional reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at 202-408-4152.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____


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